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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,116	12/06/2001	Kevin P. Baker	GNE.2830P1C15	8110

35489 7590 12/23/2005

HELLER EHRMAN LLP  
275 MIDDLEFIELD ROAD  
MENLO PARK, CA 94025-3506

EXAMINER
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VOGEL, NANCY S

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**  
**Before the Filing of an Appeal Brief**

Application No.

10/006,116

Applicant(s)

BAKER ET AL.

Examiner

Nancy T. Vogel

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
JAMES KETTER  
PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments regarding the correlation between gene amplification and protein levels, as a support for a utility of the antibody directed against said protein, remain unconvincing. Applicants repeat arguments made previously that such a correlation more likely than not exists, and that therefore, the antibody can be used in determining whether a cell is cancerous or not. For the reasons set forth previously, these arguments are not found convincing. Each of the pieces of support given by applicant, i.e. declarations and references, disclose that the correlation is not absolute. Therefore, applicant's arguments that the evidence shows that the protein in question is "more likely than not" overexpressed in tumor cells remains unconvincing. Since there is uncertainty whether gene amplification leads to increased levels of mRNA, and there is uncertainty whether increased levels of mRNA result in increased protein levels, and there remains uncertainty whether the original amplification is correlated to the cancerous cell type, there are multiple levels of uncertainty which taken together, would be understood by the ordinary artisan as a high level of uncertainty. Regarding applicant's arguments directed to possible utility or the polypeptide PRO1303 as increasing glucose and/or FFA uptake by adipocytes, applicant's arguments remain unconvincing. Applicant argues that the reference cited shows that agents that increase FFA uptake also increase glucose uptake; however, the references cited do not clearly state that this is the case for all such agents. The ability of certain drugs unrelated to the instant polypeptide (and the antibody directed against it) to affect FFA uptake and glucose uptake, and treat certain conditions, does not provide evidence that the instant polypeptide would do the same. Regarding applicant's argument concerning whether antibodies directed to a polypeptide that shares identical domains with the instant protein anticipate the instantly claimed antibodies that "specifically bind" to the protein of SEQ ID NO:194, it is maintained that the term "specifically binds" would encompass any antibody which bound with specificity, ie bound with a high affinity, to a particular protein structure. The fact that the reference polypeptide and the instant polypeptide share identical structural domains, and therefore antibodies which recognize the common domain in each, does not eliminate those antibodies from "specifically binding" to said domains of said polypeptides.